



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/100,516	06/19/98	KASTER	L 3038240/5847

HM22/0705
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EXAMINER

BENZION, G

ART UNIT	PAPER NUMBER
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1638

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DATE MAILED:

07/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/100,516

Applicant(s)

Kaster et al.

Examiner
Gary Benzlon, Ph.D.

Group Art Unit
1638



☒ Responsive to communication(s) filed on 20 Jan 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Status of the Application

Effective 24 January 2000, the Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1638.

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-11, drawn to a method of producing a plant that demonstrates herbicide resistance comprising the steps of applying a herbicide to a population of plants resistant to said herbicide at an advanced vegetative state prior to flowering, classified in Class 800, subclass 300, for example.

II. Claims 12,13 and 17-20 drawn to a method of reducing the number of herbicide susceptible offtypes in a population of herbicide resistant hybrid plants comprising spraying male parent plants with a herbicide at an advanced stage of vegetative growth such that the plants which are heterozygotic for herbicide resistance will produce pollen which shows herbicide resistance as a dominant trait, and hybrid seed produced by the method, and further a method to produce and select transformed plants, classified in Class 800, subclass 266, for example.

III. Claims 14-16, drawn to a method of producing plants which are reversibly male sterile comprising transforming a plant with a construct comprising a male gametophyte killer gene and a herbicide resistance gene, selecting transformants which is heterozygous for RSrs and either male sterile wherein herbicide is applied at an advanced vegetative stage to disable residual pollen or male fertile and growing plants in the absence of the herbicide at an advanced stage, and plants or seed obtained by the method, classified in Class 800, subclass 271, for example.

The inventions are distinct, each from the other because of the following reasons:

Group I is a distinct process and products of Groups II and III in that the process of Group I does not require the use of a transgene to produce a herbicide resistant plant in the process steps, or where a transgene is employed there is no linkage of the transgene to the process steps. In terms of claims 12 and 13, the process therein is directed to the elimination of offtype hybrid seeds by the application of a

herbicide at the appropriate time so that the pollen will show herbicide resistance. This is not required by the process of Group I.

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01) In the instant case the method of Group II, drawn to producing plants which are reversibly male sterile comprising transforming a plant with a construct comprising a male gametophyte killer gene, is not required by the process of either Groups I or II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fall into different statutory classes of invention, and are separately classified and searched, restriction for examination purposes as indicated is proper.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of the claims readable thereon, including any claims subsequent added. An argument that a claim is allowable of that all claims are generic is considered nonresponsive unless accompanied by an election.

Summary

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Inquires


Any inquiry concerning this or earlier communication from the examiner should be directed to Gary Benzion, Ph.D. whose telephone number is (703) 308-1119. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith can be reached on (703)-308-3909. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Serial No. 09/100,516
Art Unit 1638

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Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Benzion
03/24/00



GARY BENZION, P.L.D.
PRIMARY EXAMINER
GROUP ART UNIT 1649